

non-elected subject matter. Claim 21 was cancelled in the Preliminary Amendment dated Dec. 20, 2001. Claims 1-17 and 20 stand rejected.

The history leading up to this Final Action is as follows: In a telephone conversation with Applicant on 2/11/2003, Applicant made a provisional election of the invention of Group I and a provisional election of species of compound example 2 on page 150 of the application. The First Office Action, mailed 03/05/2003, requested confirmation of the provisional election of the invention of Group I and the elected of species, and included a 35 USC 102 rejection that stated only that "[c]laims 1-17 are rejected under 35 USC 102(b) as being anticipated by WO 9827061, Turner et al, Schoop et al. The references each teach the elected compound." A PTO-892 form was also mailed that listed US 6291503 (Schoop et al), US 6248739 (Turner et al), and WO 9827061 (-----).

Applicant responded to the First Office Action on 8/27/2003 confirming the provisional election of invention and of species, and stating that all three cited references had been reviewed and that applicants were unable to find the compound that was supposed to anticipate the elected species in any of them. Applicants also requested that the Examiner initial and send a copy of two previously submitted Form PTO-1449s, since neither had been received to date.

The next correspondence from the Patent Office to applicants was the Final Office Action. The entirety of the Final Action is quoted next:

"The invention is drawn to many different compounds which are encompassed by the claimed structure. The compounds vary distinctly in their specific structures, reactivity and functions. Thus, an individual search is required of each individual compound. Since thousands of compounds are encompassed by the claimed structure there is simply too many species to search. Therefore, the examination of the compounds will be limited to the compound already elected by applicant as is of record. This requirement is not to be taken as an election of species, but rather as an election of a single invention, since each compound is assumed to be a patentably distinct invention, in the absence of evidence to the contrary. Claims 18, 19 and 22 remain withdrawn from further consideration by the examiner as being drawn to non-elected subject matter. Thus, the restriction requirement is made FINAL."

Final Office Action: Election of Invention

The final office action (quoted above) appears to disregard the previous elections of invention and its corresponding election of species. The examiner states that "the examination of the compounds will be limited to the compound already elected [in the election of species] by applicant as is of record". He turned the original election of species into an election of a single

invention, ignoring the election of invention (three Groups) that he created in February, 2003, and that he included in the First Office Action mailed 03/05/2003, and upon which the applicants relied in their response to the First Office Action. In this Final Office Action, the examiner states for the first time that "each compound is assumed to be a patentably distinct invention, in the absence of evidence to the contrary."

Applicants respectfully disagree with the examiners new contention that each compound is a patentably distinct invention. First, as discussed above, a proper election of invention and species was made previously and is of record. To disregard this fact and virtually start over in the approach to this application in a final office action leaves the applicant in an untenable position. The examiner states that "the restriction requirement [in the final office action] is made FINAL." Such a statement is inappropriate. Disregarding a generic structure in favor of separately patenting the "thousands of compounds [that] are encompassed by the claimed structure", as the Examiner desires, would cause an unnecessary and unreasonable burden to both the Applicant and the Patent Office.

Applicants respectfully disagree with and can find no basis for an assumption that each compound is a patentably distinct invention because they vary in their specific structures. The examiner's First Office Action separated the disclosure into three separate inventions, one of which (elected Group I) was drawn to the compounds of Formula (I). The claims to that invention are still pending at this time. The Examiner has requested withdrawal of only non-elected subject matter from non-elected Groups II and III. The compounds claimed in the application all fall within that single depiction of Formula (I) of elected Group I. Accordingly, without further guidance from the Examiner as to why the compounds might not be structurally related, Applicants believe that the compounds of the claims of Group I are related in structure.

Additionally, the compounds of the present invention cannot be assumed to be patentably distinct because they vary in their reactivity and function. Without further guidance from the Examiner as to why he has stated that the compounds are patentably distinct based on their reactivity and function, Applicants point to the disclosure to emphasize that there is only one function of the compounds that is under consideration, and that is the compounds' ability to function as a cytostatic agent. The compounds of this invention are believed to be active as cytostatic agents that have a tumor-specific action as a result of a cleavable linkage to an alpha-v beta-3 integrin antagonist. That belief is supported by the biological data presented in the specification on pages 181 – 187. Accordingly, the compounds of the claims of Group I are related in reactivity and function.

**Applicants respectfully request withdrawal of the election described in the Final Office Action and reinstatement of the original restriction requirement** that called for withdrawal of claims 18, 19, and 22 as being drawn to non-elected subject matter (which applicants have cancelled above).

It is unclear whether the 35 USC 102 rejection from the First Office Action was overcome by applicant's previous response since no reference to it was made in the Final Office Action. In order to clearly remove this rejection from the record and move the prosecution forward, applicants resubmit that they are unable to find the compound that allegedly anticipates the elected species in any of the three references submitted by the examiner. Accordingly, **Applicants respectfully request withdrawal of the 35 USC 102 rejection from the First Office Action.**

Information Disclosure Statements

Applicants request for a second time the receipt of an initialed copy of each of the two Form PTO-1449s submitted previously with their corresponding Information Disclosure Statements on 12/21/2001 and on 7/1/2002, which have not yet been received.

Applicants believe that, in light of the cancellation of claims 18, 19 and 22, drawn to non-elected subject matter, and the arguments presented above, this application is in condition for allowance. Applicants respectfully request a timely allowance of claims 1 – 20 and 22.

Respectfully submitted,



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